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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/874,067 | 06/06/2001 | Hiroshi Fukada | 2001_0702A | 5655 |

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EXAMINER

NGUYEN, THUKHANH T

ART UNIT PAPER NUMBER

1722

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,067

Applicant(s)

FUKADA ET AL.

Examiner

Thu Khanh T. Nguyen

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 15-20 and 26-31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The mold-surface treatment process, the method of using the apparatus, and the product formed by the apparatus do not further describe the structures of the tablet machine, and each process and product could be an independent invention which might not be related to the tablet machine.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-24 recite the limitation "A₃" in the last line or second to last line. There is insufficient antecedent basis for this limitation in the claim. The specification and claim 14 fail to provide a definition so that one in the art could reasonably understand the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 14-20 and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Payson (2,753,260), or Kunitake et al (3,431,101), or the European reference (338,133).

Payson teaches a steel tool for use in hot metal dies or punches comprising high silicon-carbon steel (col. 1, lines 21-24), which could be used at high temperature (400 – 800F).

Kunitake et al teach alloy hot-working die steel comprising 1.0-3% silicon, wherein the silicon-steel alloy is undergone heat treatment (col. 2, lines 54-62) to improve hardness.

The European reference teaches a hot working press tool comprising steel and silicon for maintaining the oxidation resistance and raising the transformation temperature (page 3, lines 37-39).

In regard to claims 15-16, the process for surface treatment does not determine the patentability of the tablet machine. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the

Art Unit: 1722

prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

In regard to claims 17-20 and 26-31, the intended use of the punches or dies does not determine the patentability of the punches or dies. It has been held that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art. The applicants is required to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F. 3d 1473, 1478, 44 USPQ 2d, 1432 (Fed. Cir. 1997); See also, In re Spada, 911 F 2d 705, 708, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1977); In re Best, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and Ex Parte Gray, 10 USPQ 2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." Hewlett- Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (Emphasis in original)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1722

7. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference (338,133).

The EP reference disclose a steel press tool as describe above, in which the apparatus comprising the combination of C, Si, Cr, Mo, V, Ni, Mn, N. The C wt% is between 0.05-0.35 (claims 21-25); Si is between 0.8-2% (claim 25); Mn is between 0.1-2% (claims 21-25); Cr is between 7-13% (claim 25); Mo is between 0.5-3% (claims 22-25), V is between 0.1-0.6% (claim 24).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify the EP reference to vary the composition of the steel press tool depending on the applications and the working condition of the press. It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Response to Arguments

8. Applicant's arguments filed October 22, 2003 have been fully considered but they are not persuasive.

The applicants have argued that Payson, Kunitake and the EP reference do not disclose a tablet machine. These reference, however, disclose apparatuses for compressing powder material and are capable of forming powder material into compacted products or tablets.

The references do not disclose the surface treating process or the product that could be formed using the apparatus. However, these features do not determine the

Art Unit: 1722

patentability of an apparatus claim because the apparatus could be formed by different process and could be used to make different products.

As recognized by the Applicants, the EP reference discloses all the elements claimed by the Applicants, in different compositions. The EP reference also discloses some other elements that were not included in the current claims. Because the current claims do not exclude these elements, the present of these element would not render the claims patentable. Although, the claimed ranges of the element could be different from the prior art, most of the elements are fallen within the claimed ranges. It would have been obvious to a skilled artisan to change the composition to obtain an optimum value. It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1722

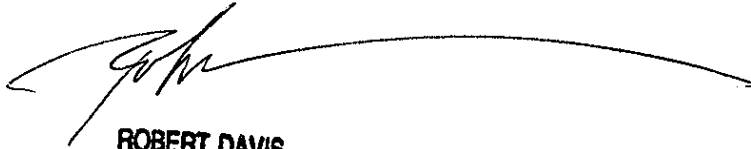
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

TN


ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1300-1700

1/12/07